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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,398	11/21/2001	Toshiyuki Mamiya	109785.03	1352

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EXAMINER
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NERBUN, PETER P

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/989,398

Applicant(s)

MAMIYA, TOSHIYUKI

Examiner

Peter P Nerbun

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-18 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

The Final rejection is withdrawn based upon the discovery of new prior art. The previous indication of allowability for claims 19 and 20 is withdrawn in view of this prior art. The present Office action is non-final.

Claims 11-18 are allowed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,8-10, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Gilbride et al or Kaempfer, both newly cited. The patent to Gilbride et al discloses a sewing apparatus where sewing is performed by causing a thread to remain in a workpiece, comprising a needle 12, Figs. 1, 2 that moves up and down to pass the thread into the workpiece, a workpiece moving device that relatively moves the workpiece with respect to the needle (Col. 3, lines 26-27 states that a conventional sewing machine is disclosed. Conventional sewing machines are well known by one of ordinary skill to include a workpiece moving device) and a holding member 10 that presses at least a part of the thread connecting two consecutive stitch points to the workpiece in accordance with a relative movement between the needle and the workpiece, wherein the holding member holds a part of the thread between one stitch point and a succeeding stitch point, and the part of the thread being held is less than the entire amount of thread between stitch points (the cylindrical shape of the holding member

adjacent to the needle tip means that the holding member must hold a part of the thread between one stitch point and a succeeding stitch point since the thread extending from the needle between one stitch and another must intersect the circle formed by the base of the cylindrically shaped holding member.). With regard to the recitation that the part of the thread being held being less than the entire amount of thread between stitch points it is noted that inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Moreover the relative diameters of the needle and cylindrical holding member necessarily means that the part of the thread being held must be less than the entire amount of thread between stitch points since the stitch penetration points could not be so close to each other that the holding member holds the entire length of thread between the stitch points.

The patent to Kaempfer discloses a sewing apparatus where sewing is performed by causing a thread to remain in a workpiece, comprising a needle 18, Fig. 2 that moves up and down to pass the thread into the workpiece, a workpiece moving device 26, Fig. 1 that relatively moves the workpiece with respect to the needle and a holding member 62 that presses at least a part of the thread connecting two consecutive stitch points to the workpiece in accordance with a relative movement between the needle and the workpiece, wherein the holding member holds a part of the thread between one stitch point and a succeeding stitch point, and the part of the thread being held is less than the

entire amount of thread between stitch points (the cylindrical shape of the holding member adjacent to the needle tip means that the holding member must hold a part of the thread between one stitch point and a succeeding stitch point since the thread extending from the needle between one stitch and another must intersect the circle formed by the base of the cylindrically shaped holding member.). With regard to the recitation that the part of the thread being held being less than the entire amount of thread between stitch points it is noted that inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Moreover the relative diameters of the needle and cylindrical holding member necessarily means that the part of the thread being held must be less than the entire amount of thread between stitch points since the stitch penetration points could not be so close to each other that the holding member holds the entire length of thread between the stitch points.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

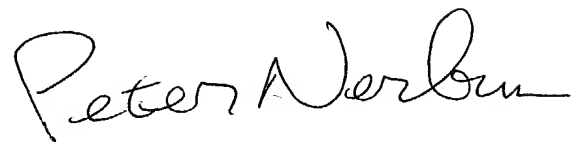
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun  
March 31, 2004

A handwritten signature in black ink that reads "Peter Nerbun". The signature is written in a cursive style with a large, looped "P" and a trailing flourish.

Peter Nerbun  
Primary Examiner